

REMARKS

I. STATUS OF THE CLAIMS

This is intended to be a full and complete response to the Office Action dated April 6, 2006. Claims 1-3, 5-8, 11, 14-16, and 19-25 are pending in this application. Claims 20-25 have been withdrawn from consideration as drawn to a non-elected invention. In view of the following discussion, the Applicants believe that all claims are in allowable form.

II. ELECTION/RESTRICTION

The Examiner has indicated that the newly submitted claims 21-25 are directed to an invention that is independent or distinct from the invention originally claimed because the new claims are drawn to a method for whitening the skin and has therefore withdrawn such claims from consideration. While applicants respectfully do not necessarily agree that a restriction requirement is proper, nevertheless applicants hereby reserve the right to prosecute claims 21-25 in related application.

III. THE CLAIMED INVENTION IS PATENTABLE OVER SLAVTCHEFF

The Examiner rejected original claims 1-3, 14-16, 19 and 20 under 35 U. S. C. § 102 (b) as being anticipated by U.S. patent 6, 270,783 to Slavtcheff et al. ("Slavtcheff"). More specifically, in reply to applicant's previous arguments that the "dry-to-the-touch" articles of Slavtcheff do not include a liquid impregnate in accord with the claimed invention, the Examiner asserted that "the strip is still impregnated with liquid, and 'dry-to-the-touch' does not mean that zero liquid is present," and thus, the Examiner maintains that the claimed invention is anticipated by Slavtcheff.

In response, Applicants respectfully submit that Slavtcheff fails to expressly or inherently teach or suggest each and every limitation of the claim, including a failure to teach an article having a *liquid impregnate having a viscosity of less than about 10,000 cps*, which is present in a *weight ratio to the substrate of greater than about 5%* and a plurality of microcapsules as claimed. In particular, applicants respectfully submit that Slavtcheff clearly fails to expressly teach an article comprising a liquid impregnate having a viscosity of less

than about 10,000 cps, let alone such an impregnate present in a weight ratio to a substrate of greater than about 5%, and the Examiner has failed to meet the Examiner's burden to assert that such claim limitations are inherent in Slavtcheff. Accordingly, the Examiner's rejection should be withdrawn and the claims allowed.

To rely upon a theory of inherency for rejections under section(s) 102/103, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Furthermore, it is well established that "the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art) (emphasis in original)).

Slavtcheff is directed to adhesive strips that are "dry to the touch," and formed by being "dried at 75°C" and then "cutting the dried strips" (see Slavtcheff at column 9, lines 1-4). There is no teaching in Slavtcheff that such process produces an article having a liquid impregnate, let alone a liquid impregnate having a viscosity as claimed and in the amounts as claimed. Moreover, the Examiner has provided no rationale to suggest that any teachings in Slavtcheff would *necessarily and invariably* result in an article having a liquid impregnate with the claimed viscosity and in the claimed amounts (nor that, for example, the claimed viscosity is even achievable in an article made via of the teachings of Slavtcheff). Applicants submit the Examiner's assertion that dry-to-the-touch "does not mean that zero liquid is present" is insufficient to meet the Examiner's burden, because, at the very least, dry-to-the-touch articles could include articles with zero liquid and would not necessarily describe a liquid impregnate with the claimed viscosity, in the claimed amounts.

Accordingly, Slavtcheff fails to teach or suggest any product for use on the skin that comprises a liquid impregnate and microcapsules in combination with a substrate as claimed. The Examiner's rejection is therefore improper and should be withdrawn.

IV. THE CLAIMED INVENTION IS PATENTABLE OVER CHARLE

The Examiner rejected original claims 1-3, 5, 8, 14-16, 19 and 20 under 35 U. S. C. § 102 (b) as being anticipated by GB 1, 304,375 to Charle et al. ("Charle). More specifically, in response to applicants arguments that the "dried towel" articles of Charle do not teach a liquid impregnate in accord with the claimed invention, the Examiner has acknowledged Charle teaches a dried towel. However, the Examiner asserts that "the towel is still impregnated with a liquid, and that 'dried towel' does not mean that zero liquid is present, that is, the towel is not dripping wet certainly, but some cream must be present for application to the skin."

In response, Applicants respectfully submit that Charle, like Slavcheff, fails to teach or suggest any product for application to the skin that comprises a liquid impregnate with the claimed viscosity and in the claimed amounts, in combination with a water-insoluble substrate, and a plurality of microcapsules comprising a microcapsule wall surrounding a liquid core. Moreover, the Examiner has not provided evidence that such teachings are inherent in any manner in Charle. Applicants submit the Examiner's assertion that a "'dried towel' does not mean that zero liquid is present" is insufficient to meet the Examiner's burden, because, at the very least, a "dried towel" could include towels with zero liquid and would not necessarily describe an article having liquid impregnate with the claimed viscosity, in the claimed amounts. Applicants further assert that the Examiner has provided no indication as to how a dried towel made in accord with the teachings of Charle could achieve a towel having a liquid impregnate with a viscosity as claimed in combination with microcapsules as claimed. Accordingly, Charle fails to teach or suggest any product for use on the skin that comprising a liquid impregnate in combination with a substrate as claimed, and the claimed invention is patentable thereover.

V. THE CLAIMED INVENTION IS PATENTABLE OVER NORBURY

The Examiner rejected original claims 1-3, 5-8, 14-16, 19 and 20 under 35 U. S. C. § 102 (b) as being anticipated by US 4, 878,775 to Norbury et al. ("Norbury").

In response, Applicants respectfully submit that Norbury, like Charle and Slavcheff, fails to teach or suggest any product for application to the skin that comprises a liquid impregnate as claimed, in combination with a water-insoluble substrate, and a plurality of microcapsules comprising a microcapsule wall surrounding a liquid core. Rather, Norbury describes only dry liquid applicators (see Norbury at column 1, line 40). The applicator comprises a support/structural layer and microcapsules containing liquid, but no liquid impregnate. Accordingly, Norbury fails to teach or suggest any product for use on the skin that comprises a liquid impregnate in combination with a substrate and microcapsules as claimed, and the claimed invention is patentable thereover.

The Examiner asserts that "...when the liquid-filled impregnated capsules are ruptured, the liquid flows into the web. At this point the liquid impregnate limitation is satisfied." Applicants respectfully submit that Norbury does not expressly or inherently teach an impregnate having the Applicant's weight ratio and viscosity limitations in combination with microcapsules. Accordingly, Norbury fails to teach or suggest the claimed invention, and the rejection should be withdrawn.

V. THE CLAIMED INVENTION IS PATENTABLE OVER LANG

The Examiner rejected original claims 1-3, 5-8, 11, 14-16, 19 and 20 under 35 U. S. C. § 103 (a) as being unpatentable over U.S. patent 6, 429,261 to Lang et al. ("Lang"). More specifically, the Examiner acknowledged that Lang does not specifically teach a wipe containing all claimed elements, including microcapsules, but nevertheless asserts that it would have been obvious to incorporate microcapsules in a wipe according to the teachings of Lang to achieve the claimed invention. Further, in response to applicants demonstration of unexpected results associated with the claimed invention as compared to the prior art, the Examiner asserted that Applicants' "unexpected results are not commensurate with the scope of the claims at hand. A product is being claimed, not a method for whitening the skin."

In reply, applicants respectfully submit that contrary to the Examiner's assertion, it has long been recognized that evidence of unexpected superiority in a property associated with a *compound or product*, as compared with the prior art, may be used to rebut a *prima facie* case of obviousness. MPEP716.02(a). Moreover, "[e]vidence that a compound is

unexpected superior in one of a spectrum of common properties...can be enough to rebut a *prima facie* case of obviousness.” MPEP 716.02(a) (citing *In re Chupp*, 816 F.2d 643,646, wherein evidence showing a claimed *compound* was more effective at “controlling quackgrass and yellow nutsedge weeds in corn and soybean crops was sufficient to overcome the rejection under 35 U.S.C. 103, even though the specification indicated the claimed compound was an average performer on crops other than corn and soybean.” Emphasis added.) Applicants note that there is no requirement that a demonstration of a superior property associated with a compound or article is only applicable to a method of producing such property (*In re Chupp* mentions a claimed compound, not a method of controlling quackgrass and yellow nutsedge weeds).

In light of the above, applicants respectfully submit that the Examiner’s assertion that applicants’ demonstration of an unexpected superior results is not commensurate with the scope of the claimed invention because a “product is being claimed, not a method for whitening the skin” is improper. Rather, applicant’s demonstration of superior whitening properties associated with the articles within the scope of the claims at hand, as compared to prior art articles outside such scope, is properly submitted as evidence of unexpected results associated with the articles claimed, and must be considered by the Examiner.

As previously noted, applicants respectfully submit that Lang fails to provide any teaching, suggestion, or motivation to specifically select the claimed elements from among the laundry list of optional components listed therein to achieve the claimed invention and the unexpected results discovered by applicants to be associated therewith. Accordingly, the claimed invention is patentable thereover.

As illustrated in the instant application, applicants have discovered that the products of the claimed invention comprising a liquid impregnate having a viscosity of less than about 10,000 cps and a plurality of microcapsules comprising a microcapsule wall surrounding a liquid core, and methods of using such product, tend to achieve unexpectedly high increase in whitening to the skin (and other beneficial properties) as compared to products outside the claimed invention. For Example 1 and Comparative Example 1 illustrate that certain products of the claimed invention are useful in increasing whiteness to the skin, while comparative products tend to be significantly less useful in increasing whiteness to the skin.

Lang, on the other hand, discloses a variety of products which may or may not include any of a laundry list of liquids, microcapsules, and/or other optional components. Lang fails, however, to provide any teaching or suggestion to specifically select and combine a liquid impregnate having a viscosity of less than about 10,000 cps and a plurality of microcapsules with a substrate to achieve a product of the claimed invention, or that such combination has unexpected superior properties associated therewith as compared to other products described in Lang. Thus, one of skill in the art would not be motivated by Lang to select and achieve the specific combination of components claimed by applicants, and the claimed products are patentable thereover.

VI. CONCLUSION

In light of the amendments and remarks herein, Applicants submit that all claims now pending are in condition for allowance. Accordingly, both reconsideration of this application and swift passage to issue are earnestly solicited. If the Examiner believes that any unresolved issues still exist, it is requested that the Examiner telephone Brett Freeman at 732-524-3428 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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